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UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Satoshi KIDOOKA et al.

Group Art Unit: 1641

Appln No : 09/735,551

Examiner: Ann Y. LAM

Filed : December 14, 2000

For : ENDOSCOPIC SPRAYING INSTRUMENT

### **PRE-APPEAL BRIEF REQUEST FOR REVIEW**

U.S. Patent and Trademark Office  
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401 Dulany Street  
Alexandria , VA 22314

Sir:

In response to the outstanding Final Official Action of May 15, 2006, setting a shortened statutory period for response to expire on August 15, 2006 and for which a Notice of Appeal is being concurrently filed, Applicants respectfully request a Pre-Appeal Brief Panel to review and withdraw the outstanding rejections set forth in the above-mentioned Final Official Action in view of the herein-contained remarks.

In the outstanding Final Official Action, each of claims 1, 3-5 and 29 was rejected under 35 U.S.C. § 103(a) as being unpatentable over JPU 7-51066 to SHIMIZU in view of U.S. Patent No. 6,010,478 to BELLHOUSE. Independent claim 1 recites:

1. An endoscope comprising:  
a treatment instrument channel; and  
an endoscopic spraying instrument comprising:  
a liquid supplying tube configured to pass liquid therethrough and further configured be removably inserted into the treatment instrument channel;  
a rotatingly guiding groove disposed at a leading end side of the supplying tube and configured to rotate the liquid about a central axis;

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a liquid rotating chamber disposed at a leading end side of the rotatingly guiding groove, the liquid rotating chamber configured to rotate the liquid therein;

a spray nozzle formed in a leading end wall of the liquid rotating chamber and configured to discharge the liquid from the liquid rotating chamber;

a wall surface outwardly extending from an outer periphery of the spray nozzle and defined by one of a tapered surface and a curved, concave surface; and

an annular, protruded wall extending in a forward direction and at an angle different from said wall surface, wherein said annular, protruded wall is configured to reflect liquid ejected from said spray nozzle.

A non-limiting feature of a presently claimed embodiment provides an endoscopic spraying instrument which can spray liquid uniformly over all directions. In the prior art, as described in pages 1-2 of Applicants' invention, it is noted that it is preferable to have an endoscopic spraying instrument uniformly spray liquid using a wide spraying angle; however, due to processing or assembling errors, prior art endoscopic spraying instruments such as that shown in Figs. 5-6 may cause the liquid to flow over the cap 94, making the spraying state unstable.

To address this problem with the prior art, Applicants provided an endoscopic spraying instrument having an annular, protruded wall extending in a forward direction and at an angle different from the wall surface, the annular, protruded wall configured to reflect liquid ejected from the spray nozzle.

In the outstanding Final Official Action, the Examiner noted that BELLHOUSE teaches the claimed limitation of an annular, protruded wall extending in a forward direction and at an angle different from said wall surface, wherein said annular, protruded wall is configured to reflect liquid ejected from said spray nozzle, and concludes that it would have been obvious to include this feature into the device of SHIMIZU.

In Applicants' Amendment and Response of February 28, 2006 (the arguments of which, together with all arguments proffered in Applicants' other previous responses filed over the nearly six-year prosecution of the present application, are expressly incorporated herein), Applicants asserted that BELLHOUSE is not directed to a spray nozzle or a nozzle that sprays a liquid, but rather is directed to a syringe that accelerates a powdery material across skin or mucosal tissue, and further asserted that BELLHOUSE's "wall surface extending in a forward direction" identified by the Examiner is a soft, annular spacer 13 that serves as a buffer area between the nozzle portion 7 and target tissue, and as such, BELLHOUSE cannot teach or suggest at least a wall that reflects liquid ejected from a spray nozzle. In the "Response to Arguments" section of the Final Official Action, the Examiner noted that Applicants' assertions were not persuasive "because the annular, protruded wall disclosed by BELLHOUSE is capable of reflecting liquid ejected from a spray nozzle . . ." While such may be the case, the Examiner has completely failed to provide any motivation to combine the wall surface of BELLHOUSE with the nozzle of SHIMIZU.

Applicants further argued in the Amendment and Response of February 28, 2006, that the since the present invention is directed toward an endoscope having a liquid spraying nozzle; and the BELLHOUSE reference is directed toward a needleless syringe capable of accelerating particles across skin or mucosal tissue, the present claimed invention and the applied BELLHOUSE reference are non-analogous.<sup>1</sup> In the "Response to Arguments" section of the Final Official Action, the Examiner noted that Applicants' argument was not persuasive because the combination of the SHIMIZU and BELLHOUSE references is appropriate and are analogous art "in that they are both are related to medical devices." However, the Examiner fails to appreciate that an allegation that both references are "medical

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<sup>1</sup> Applicants appreciate the Examiner pointing out Applicants' clerical error in this regard.  
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devices” has no bearing on whether they are analogous or not. Under the Examiner’s reasoning, an eye patch (which may be said to be a medical device) would be considered analogous art. Further, even if the Examiner is correct (which she is not) in the assertion that the combination of SHIMIZU and the annular, protruded wall of BELLHOUSE “teach the structural limitations of the claimed invention,” such an assertion provides no motivation whatsoever for properly combining the structural limitations of BELLHOUSE with those of SHIMIZU. Additionally, the endoscope and spray nozzle recited in Applicants’ claim 1 and the syringe of BELLHOUSE are utilized in completely different manners, which further evidences the impropriety of the Examiner’s combination of the teachings of BELLHOUSE with those of SHIMIZU (the latter being a spray nozzle used in generally the same manner as Applicants’).

In the Amendment and Response of February 28, 2006, Applicants called the Examiner’s attention to page 8, lines 10-13 of the specification, which notes that the structure of the present invention “showed a remarkable advantage,” in order to counter the Examiner’s assertion that “a change in size or shape is generally recognized as being within the level of ordinary skill in the art.” However, in the Final Official Action, the Examiner noted that Applicants’ assertion is not persuasive because “the structure of the present invention is suggested by the prior art as discussed above and Applicant has not shown that the claimed structure provides any unexpected results.” Applicants note that the Examiner erroneously presupposes that a showing of unexpected results is required to overcome a finding that a change in size or shape is within the level of ordinary skill in the art. Rather, in this Amendment and Response, Applicants were demonstrating that the configuration of the present claimed invention offers improved results over the prior art, which is discussed in detail throughout the entire specification. Moreover, the Examiner’s assertion noted

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above is a conclusion of obviousness without a factual basis. It is thus respectfully submitted that claim 1 and the claims dependent therefrom are patentable over the applied references.

With respect to the Examiner's rejection of dependent claims 3-5, 29 and 32, since these claims are dependent from allowable independent claim 1, which is allowable for at least the reasons discussed *supra*, these dependent claims are also allowable for at least these reasons. Further, all dependent claims recite additional features which further define the present invention over the references of record.

For example, with respect to the Examiner's rejection of newly-added claim 32, in which she noted that Fig. 3 of BELLHOUSE discloses the claimed annular, protruded wall being generally coaxial with the wall surface, Applicants note that Fig. 3 of BELLHOUSE completely fails to disclose the claimed annular, protruded wall surface, which further supports Applicants' assertion that the Examiner has, based upon Applicants' own disclosure, picked various individual features of the references (and the various embodiments shown within the references) and has combined them in the manner taught by Applicants' disclosure, which is improper hindsight reconstruction. It is thus respectfully submitted that all rejected claims are patentably distinct from the references of record.

Should the Examiner have any questions or comments regarding this paper, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

August 14, 2006  
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